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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

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Filing Date: October 23, 1998
Appellant(s): MAUROMMATI ET AL

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Robert M. McDermott, Attorney
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 25, 2001.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3) . *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 stand or fall together.

(8) *Claims Appealed*

A substantially correct copy of appealed claim 9 appears on page 8 of the Appendix to

the appellant's brief. The minor errors are as follows: claim 9 is indicated as dependent on claim

4. However, Amendment B filed on 1/2/2001 amended claim 9 to be dependent on claim 3.

(9)   ***Prior Art of Record***

IBM Technical Disclosure Bulletin. "Dynamic Icon Presentation", Vol. 35, No. 48

(September 1992), pp. 227-232.

5,742,779   STEELE ET AL   4-1998

(10)   ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele et al.

("Steele", US # 5,742,779) in view of IBM Technical Disclosure Bulletin ("IBM TDB", Vol. 35,

Issue 4B, pp. 227-232; Sept. 1992).

As per claim 1, Steele teaches an information processing system comprising: a display;

processing means, arranged for displaying in a first field (fig. 7A) on the display a first sequence

of first icons (fig. 7A, *icons such as actors and things which belong to the parent "TOLFA" on*

the hierarchy), and selecting means, arranged for selecting the selectable first icon, characterized

in that the processing means are arranged for displaying, upon selection of the selectable first

icon, in a second field (fig. 7B) on the display a second sequence of second icons (fig. 7B, *icons*

such as home and hospital which belong to the parent "things" on the hierarchy), and that the

selecting means are arranged for selecting the selectable second icon (col. 12, line 66 – col. 13,

line 20).   Steele fails to teach the displaying of a sequence of icons in a timed loop and

repeatedly making the currently displayed icon selectable to be applicable to both the first and

second sequence of icons. IBM TDB teaches a method to greatly compact the presentation of a

plurality of icons while allowing selection of one of the plurality of the icons by presenting, in

time sequence, each icon of a set of icons (figs 1-2; page 228). It would have been obvious to an

artisan at the time of the invention to apply IBM TDB's teaching with Steele's method at each

hierarchical level in order to provide a more compact presentation resulting in a more efficient

use of screen real estate.

As per claims 2-4, as already addressed in previous paragraphs, the system of Steele and

IBM TDB teaches the processing means to be arranged for displaying, upon selection of the

selectable first or second icon, an information item in an output field on the display; wherein the

information item comprises a sequence of information sub-items in a timed loop (Steele: figs 7A

and 7B; col. 12, line 66 – col. 13, line 20; and IBM TDB: page 1, paragraphs 1-3 after the

citation header; figs 1-2).

Claims 5-8 are similar in scope to claims 1-4 respectively, and are therefore rejected

under similar rationale.

Claims 9-10 are similar in scope to claim 4, and are therefore rejected under similar

rationale.

(11)   Response to Argument

Applicant argues that: (a) Steele presents all of the options available to a user at each

hierarchy level simultaneously and is silent with regard to a sequential presentation options of

individual option, and while the IBM TDB teaches the presentation of options sequentially, the

teaching is silent with regard to a hierachical menu structure---thus, impermissible hindsight

reconstruction is used to arrive at the Applicants' invention; and (b) even if combinable, while

the Applicants specifically teach and claim a method and system wherein each group of

selectable icons is presented sequentially in a defined field on a display, Steele teaches the simultaneous display of selectable icons in one area, and the subsequent relocation of the icon, or a miniaturized version of the icon, to another area---thus, the replacement of Steele's elevator window with the IBM TDB approach and the replacement of Steele's elevator with the Applicant's hierarchy-dependent display, produces a replacement of Steele's teachings in their entirety.

The examiner disagrees for the following reasons:

Per (a), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Steele teaches the presentation of all options iconically available to a user at each hierarchy level, and the IBM TDB teaches the displaying of a sequence of icons in a timed loop and repeatedly making the currently displayed icon selectable to be applicable to the first and second sequence of icons. It would have been obvious to an artisan to combine the teachings in order to "reduce screen clutter and conserve screen real estate" (IBM TDB, page 227, lines 4-5)

when using IBM TDB's timed loop presentation of a Dynicon to present all of Steele icon options at each hierarchy level.

Per (b), Steele teaches a method for displaying in a first field a plurality of first icons (fig. 7A, the field containing icons actors, actions etc.), and upon the selection of the selectable first icon, in a second field on the display a second plurality of second icons (fig. 7B, the field containing icons labeled home, hospital etc.). Thus, when combined with the teaching of IBM TDB, it would have been obvious to an artisan that each group of selectable icons is presented sequentially in a defined field on a display. Moreover, claim 1 does not explicitly recite the first and second fields on the display to be separate fields which are to be displayed concurrently on the display as implied by the Applicant's argument.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

For the above reasons, it is believed that the rejections should be sustained.

September 26, 2001   Respectfully submitted,

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